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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,782	01/17/2002	Yoichi Okano	8019-1001	2634

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EXAMINER

DURAN, ARTHUR D

ART UNIT	PAPER NUMBER
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3622

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/046,782

Applicant(s)

OKANO, YOICHI

Examiner

Arthur Duran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>1/17/02</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Claims 1-32 have been examined.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3-14, 16-26, and 28-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merritt (7,058,593).

Claims 1, 14, 26: Merritt discloses a prize advertisement service system where a desired advertisement is conducted by conducting a prize advertisement is conducted on a communication network, and data about applicants who apply for said prize advertisement is collected, comprising:

(a) a first terminal of a prize advertisement presenter who presents a prize advertisement

(Abstract, Fig. 1);

(b) a second terminal of a user who applies for said prize advertisement (Abstract, Fig. 1); and

(c) a server of a service provider which connects said first and second terminals to each other through a communication network, said server including functions of (Fig. 2a,

'www.cstakes.com' website, system, and service):

(c1) registering prize advertisements into said server in accordance with prize advertisement

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information received from said first terminal (Fig. 3, 'Present a Prize', 'Advertise with us';
Figures 14, 20a);

(c2) registering a user who wants to apply for said prize advertisements, in accordance with user
information received from said second terminal (Figures 2, 2a, 6);

(c3) selecting one or more prize advertisement(s) which matches to said user, among the
registered prize advertisements, in accordance with said user information (col 1, lines 47-51);

(c4) transmitting data indicative of a list of the selected prize advertisement(s), to said
second terminal (Fig 39-1; Fig. 11; Fig. 33);

(c5) receiving an application of said user for one or more prize advertisements among the listed
prize advertisement(s), from said second terminal (Figures 28-1, 29; col 10, lines 15-30); and

(c6) transmitting the user information of said user having applied for said prize advertisements,
to said first terminal as applicant data indicative of an applicant or applicants applying for said
prize advertisement(s) (Figures 3, 9, 10, 29; col 10, lines 15-30).

Merritt does not explicitly disclose that the prize presenter can also be an advertiser.

However, Merritt discloses prize presenters. And, Merritt discloses advertisers. And, Merritt
discloses that the prize presenters can also be selling goods and services.

Therefore, it would have been obvious to one having ordinary skill in the art at the time
the invention was made that Merritt's prize presenters can also be advertisers. One would have
been motivated to do this in order to present a way to better promote the products for sale.

Also, it is obvious that presenting purchasable goods/items as prizes (Fig. 3) also
functions as advertising for that good/item. One would be motivated to do this in order to
increase exposure of goods/items and to increase sales.

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Also, the wish list of Merritt functions as a list of preferences for a user such that a user is presented a list of prizes based on the preferences/wish list of a user.

Alternatively, Merritt discloses that prizes are selected for listing and to be presented to a user (Fig. 33). And, Merritt discloses that there is a database that lists all prizes (col 7, lines 1-20), but that only a sample or a few of the total available prizes are initially presented (col 10, lines 30-46; Fig. 4). And, Merrit discloses tracking which prizes a user has selected (col 10, lines 15-30). And, Merritt discloses tracking users preferences (col 7, Table 1; Fig. 2a) and Merritt discloses targeting users based on profiles (col 7, lines 1-20; claim 1).

And, MPEP 2144.04.VI discloses that reversal, duplication, and rearrangement of parts is obvious.

Therefore, it would be obvious that the limited prizes list that is presented to the user based on a wish list can also be presented be to the user based on the user preferences/profile. One would be motivated to do this in order to present prizes that are of interest to the user.

Claim 3, 16, 28: Merritt further discloses that said server further has a function of administrating the number of applications of a user for said prize advertisement(s) listed in said list, and deciding presenting a special award to a user who applied for said prize advertisement(s) by the predetermined number (Fig. 12b, Drawing).

Claim 4, 17, 29. Merritt further discloses that said first terminal has a function of selecting one or more applicant(s) among the applicants identified by said applicant data transmitted from said server, for presenting a prize identified in said prize advertisement(s) thereto, by

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drawing lots (Fig. 12b, 'Drawing').

Claim 5, 18, 30; 9, 22: Merritt further discloses that said first terminal further has a function of managing delivery of a prize presented in said prize advertisement(s), to the selected user(s), based on the result of said lots (col 3, lines 48-61).

Claim 6, 19: Merritt further discloses that said server further has a function of drawing lots for selecting one or more user(s) among the users to which said special award was presented (Fig. 12b, 'Drawing').

Claim 7, 20: Merritt further discloses that said server further has a function of managing delivery of a prize to the selected user(s), based on the result of said lots (column 3, lines 48-61). Note that the server/service providing and maintaining the address information (Fig. 2a) can function as managing the delivery of the prizes.

Claim 8, 21, 31: Merritt further discloses that said server further has functions of: selecting one or more applicant(s) among the applicants of said prize advertisement(s), for presenting a prize identified in said prize advertisement(s) thereto, by drawing lots; and transmitting data indicative of the selected applicant(s) to said first terminal as prize-winner data (Fig. 12b).

Claim 10, 23, 32; 11, 24; 12, 25: Merritt further discloses that said prize transmitted from said first terminal to said second terminal of said

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selected applicant(s) is comprised of electronic data (Fig. 3, item 'Cash', item 'Events/Travel', item 'Giftware').

Claim 13: Merritt discloses the above.

Merritt does not explicitly disclose that said second terminal is comprised of a cellular phone.

However, Merritt discloses that the user utilizes the Internet and a terminal (Abstract). Merritt further discloses that the user's phone number is known (Fig. 2a).

Examiner further notes that MPEP 2144.04.V discloses that making a device portable is obvious.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the terminal can be a cell phone. One would have been motivated to do this in order to better utilize a medium and device that is available and common to users.

3. Claims 2, 15, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merritt (7,058,593) in view of Dedrick (5,724,521).

Claim 2, 15, 27: Merritt further discloses that said server determines the number of prize advertisements listed in said list, in accordance with said user information, when said server selects said one or more prize advertisement(s) (col 12, lines 20-60).

Merritt does not explicitly disclose that the number of prize advertisements are selected in accordance with application frequency predetermined in said user information.

However, Dedrick discloses that the number of advertisements are selected in accordance with application frequency predetermined in said user information. Dedrick discloses a user

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profile that can be modified by the system and/or user (col 7; lines 25-35). And, Dedrick discloses that it can be set as to how many advertisements per time period are presented to a user in a list (col 9, lines 50-63; col 10, lines 55-60).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Dedrick's number in a list of advertisements per time period to Merritt's presenting a limited list of prize advertisements and profiling a user. One would have been motivated to do this in order to present an amount of prizes of interest to that particular user.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:


- a) Goldhaber (5,794,210) discloses advertising and providing compensation for attention.
- b) Eggleston (6,061,660) discloses presenting prizes and advertising on a website and targeting the user for prizes.
- c) Kelly (6,015,344) discloses prizes, advertising, and targeting.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Arthur Duran
Primary Examiner
11/13/2006